

## **REMARKS / ARGUMENTS**

### **I. General Remarks**

Please consider the application in view of the following remarks.

### **II. Disposition of Claims**

Claims 39-76 are pending in this application.

In this Response, claims 1-38 have been cancelled, and the substance of those claims is presented in new claims 39-76. These new claims contain no new matter, and are supported by the specification as filed. The Examiner's objections to and rejections of claims 1-38 are addressed below as they apply to these new claims.

Claims 1-6, 8, 10, 12, 14, 16-18, 20-25, 27, 29, 31, 33, and 35-37 stand rejected under 35 U.S.C. § 102(b). Claims 1-38 stand rejected under 35 U.S.C. § 102(e). The Examiner has objected to claims 8, 14, 15, 27, 33, and 34.

### **III. Objections to the Specification**

The Examiner objected to the abstract of the disclosure as improper for including the phrase "the present invention" in lines 1 and 3. Applicant has amended the abstract of the disclosure in response to the Examiner's objection, and to remove the paragraph number from the abstract. Thus Applicant respectfully requests the withdrawal of the Examiner's objection to the abstract.

### **IV. Objections to Claims**

The Examiner objected to claims 8, 14, 15, 27, 33, and 34 for using several terms without sufficient antecedent basis. Applicant has cancelled these claims and re-written them in a manner consistent with the Examiner's requests for amendment, and thus Applicant respectfully requests the withdrawal of these objections to the claims.

### **V. Rejections of Claims**

#### **A. Rejections of Claims Under 35 U.S.C. § 102(b)**

Claims 1-6, 8, 10, 12, 14, 16-18, 20-25, 27, 29, 31, 33, and 35-37 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,944,105 to Philip D. Nguyen ("the '105 Patent"). With respect to this rejection, the Examiner writes:

[The '105 Patent] discloses a method that includes, with respect to claims 1 and 20, a method of drilling a well bore (or consolidating formation particulates surrounding a well bore) comprising the steps of: providing a drilling composition comprising a drilling

fluid and a consolidating material; and using the drilling composition while drilling the well bore and allowing the consolidating material in the drilling composition to penetrate into the walls of the well bore. With respect to the depending claims, the reference teaches the limitations as claimed, including the consolidation material comprising a hardenable resin component, the hardenable resin component comprising a hardenable resin and a hardening agent component, a liquid hardening agent (including amino functioning groups), a silane coupling agent (including aminosilanes), a surfactant, fluid loss control material, and a furfuryl alcohol resin-type coating material.

(Office Action at ¶ 5.) Applicant respectfully traverses these rejections insofar as they may apply to new claims 39-76.

In order to form a basis for a rejection under 35 U.S.C. § 102(b), a prior art reference must disclose each and every element as set forth in the claim. MANUAL OF PATENT EXAMINING PROCEDURE § 2131 (2004). Applicant respectfully submits that the '105 Patent does not teach or suggest any method using a drilling composition to drill at least a portion of a well bore wherein the drilling composition comprises both a drilling fluid and a consolidating material, as recited in claims 39 and 58.

First, the '105 Patent does not teach using a drilling composition to drill at least a portion of a well bore. In the methods taught in the '105 Patent, a “fluid” and a “hardenable permeable material” are each pumped into a well bore, but then the drill string and well stabilization tool are removed while the hardenable permeable material is allowed to set. Only after this setting step is a portion of the well bore drilled. (See '105 Patent at col. 11, ll. 1-21.) However, the '105 Patent does not teach or suggest any method of drilling wherein the “fluid” or any other drilling composition is used while drilling the well bore, as recited in claims 39 and 58.

Moreover, the '105 Patent does not teach using a drilling composition that comprises both a drilling fluid and a consolidating material. Indeed, the '105 Patent teaches the use of two distinct elements: (1) “pumping fluid” into the well bore “whereby the diameter of that portion of the wellbore is enlarged by fluid jet erosion,” and then (2) pumping a “hardenable permeable material” into the well bore “whereby the enlarged portion of the wellbore is filled with the permeable material.” (See '105 Patent at col. 11, ll. 1-11.) However, the '105 Patent does not teach or suggest the use of a single drilling composition to drill at least a portion of a

well bore that comprises both a drilling fluid and a consolidating material, as recited in claims 39 and 58.

Applicant therefore respectfully asserts that the '105 Patent does not disclose all elements of claims 39 and 58, and thus these claims are allowable over the '105 Patent. Moreover, since "a claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers," and since claims 40-57 and 59-76 depend, directly or indirectly, from claim 39 or 58, these dependent claims are allowable for at least the same reasons. *See* 35 U.S.C. § 112 ¶ 4 (2004). Accordingly, Applicant respectfully requests the withdrawal of these rejections.

**B. Rejections of Claims Under 35 U.S.C. § 102(e)**

Claims 1-38 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Serial No. 10/613,487 (Publication No. 2005/0000731) by Nguyen *et al.* ("the '487 Application"). Applicant respectfully traverses these rejections insofar as they may apply to new claims 39-58.

In order to form a basis for a § 102(e) rejection, the earlier patent or patent application must be "by another." *See* 35 U.S.C. § 102(e). Submitted herewith is a declaration under 35 U.S.C. § 1.132 showing that the relevant disclosure in the '487 Application is Applicant's own work, and thus the invention disclosed therein is not by "another." *See* MANUAL OF PATENT EXAMINING PROCEDURE § 716.10 (2004). Accordingly, Applicant respectfully submits that the 35 U.S.C. § 102(e) rejection of claims based on the '487 Application, insofar as it may apply to new claims 39-58, has been overcome, and respectfully requests the withdrawal of these rejections.

**SUMMARY**

In light of the above remarks, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections. Applicant further submits that the application is now in condition for allowance, and earnestly solicits timely notice of the same. Should the Examiner have any questions, comments or suggestions in furtherance of the prosecution of this application, the Examiner is invited to contact the attorney of record by telephone, facsimile, or electronic mail.

Applicant believes that there are no fees due in association with this filing of this Response. However, should the Commissioner deem that any additional fees are due, including any fees for extensions of time, Applicant respectfully requests that the Commissioner accept this as a Petition therefor, and directs that any additional fees be charged to the Deposit Account of Halliburton Energy Services, Inc., No. 08-0300.

Respectfully submitted,



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